



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/530,563

04/07/2005

Takao Hasegawa

040894-7216

8997

9629 7590 05/28/2008
MORGAN LEWIS & BOCKIUS LLP
1111 PENNSYLVANIA AVENUE NW
WASHINGTON, DC 20004

EXAMINER

REYNOLDS, STEVEN ALAN

ART UNIT

PAPER NUMBER

3728

MAIL DATE

DELIVERY MODE

05/28/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/530,563	HASEGAWA ET AL.	
	Examiner	Art Unit	
	Steven Reynolds	3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10 and 14-30 is/are pending in the application.
- 4a) Of the above claim(s) 22-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10, 14-21 and 28-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/16/2008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/18/2008 has been entered.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

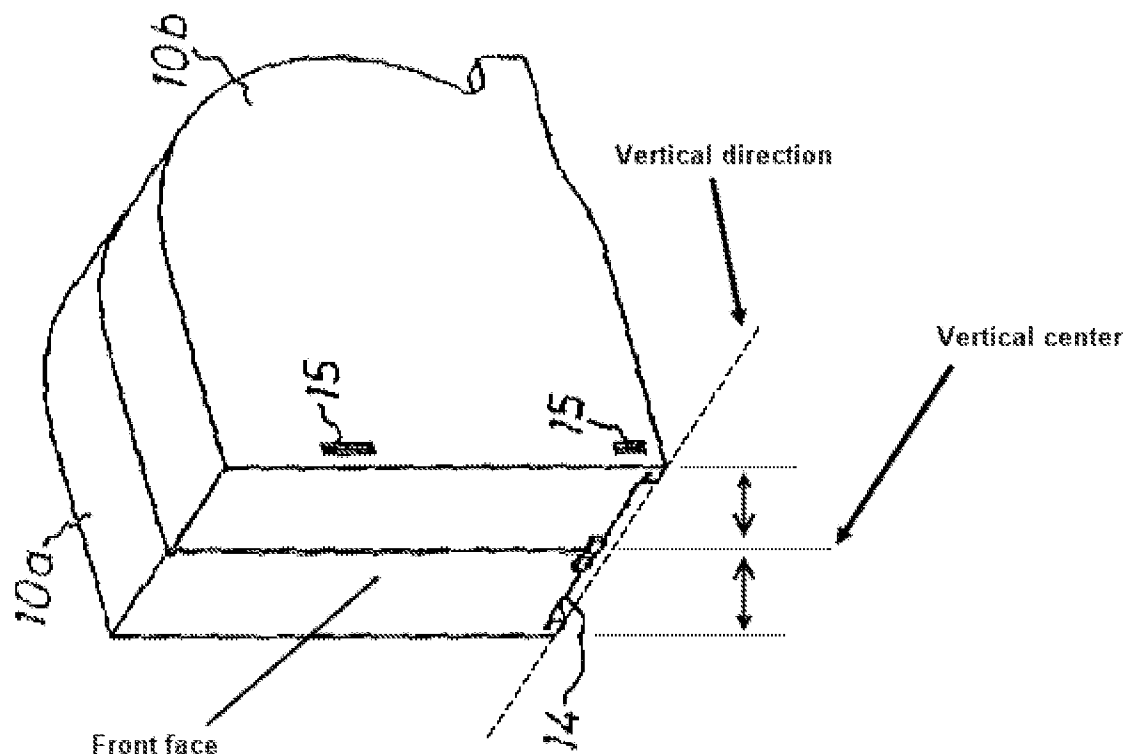
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 10, 14-19 and 28-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Straat (US 5,794,833). Straat discloses a staple case (10) that contains a roll staple (9) formed by connecting unformed staples in a roll shape comprising: an opening (29), formed at a part of the staple case, and through which a member for rotating the roll staple is capable of being brought into contact with a circumferential surface of the roll staple, wherein a direction from a center of the roll staple to the opening and a tangent line of a portion of the roll staple where the member is brought into contact with the circumferential surface of the roll staple are substantially

Art Unit: 3728

orthogonal; a pull-out opening (14) through which the roll staple is pulled out; the pull-out opening is provided at a vertical center of a front face of the staple case (since no reference point for the orientation of the case is claimed, the case of Straat can be oriented in a position where the pull-out opening is at a vertical center of a front face).

As shown in the figure below, the case can be oriented so that the pull-out opening (14) is vertically centered on the front face of the staple case.

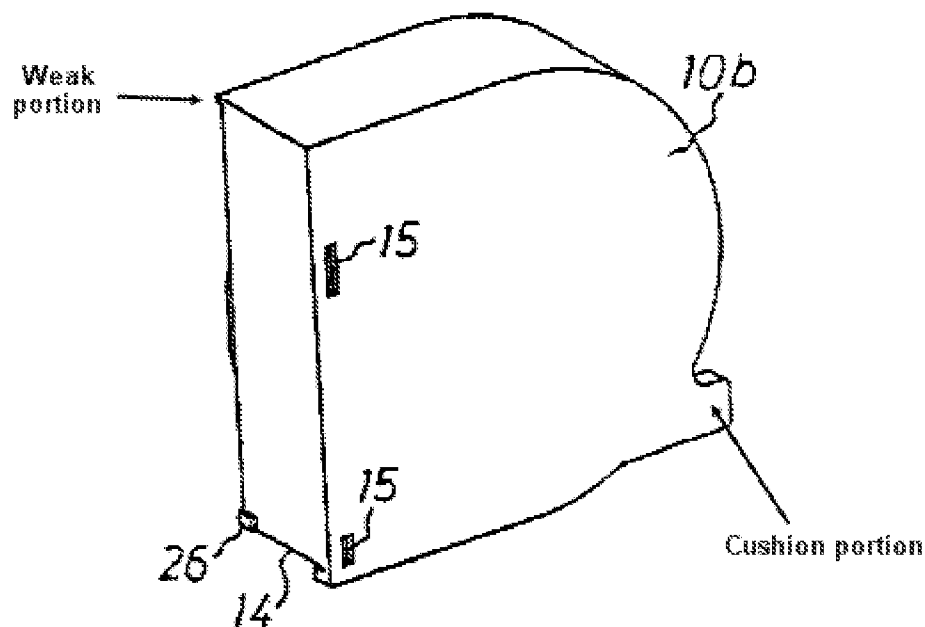


Regarding the intended use of the claimed invention “an opening....through which a member for rotating the roll staple is brought into contact with a circumferential surface the roll staple”, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the

Art Unit: 3728

claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. If the prior art structure is capable of performing the intended use, then it meets the claim. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Regarding claims 14-17, Straat discloses a cushion portion (See figure below); a portion (side wall) for positioning in a containing chamber; a guide portion (front wall) for guiding the staple case to a containing chamber; a first case half (10a); and a second case half (10b).



Regarding claims 18-19 and 28-30, Straat discloses a first opening through which the roll staple is pulled out; and a second opening synonymous with the opening through which a member for rotating the roll staple is brought into contact with the roll staple, wherein the first opening is provided on the second case half, and the second opening is provided on the first case half; a weak portion (See figure above) on a joint between the first case half and second case half; the staple case is attachable to and

Art Unit: 3728

detachable from an electric stapler; the staple case is attachable to and detachable from a staple cartridge that is attachable to and detachable from an electric stapler; and a staple pull-out opening; wherein the direction from the center of the roll staple to the staple pull-out opening and a direction in which the roll staple is fed out from the pull-out opening are substantially orthogonal.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Straat (US 5,794,833) in view of Haramiishi (US 7,048,165). Straat discloses an upper/front face (10a) and a bottom/back face (10b) having a different shape to the upper face (10a and 10b have different "weak portions" as seen in figure above). Straat

discloses all the limitations of the claims except for the specifics of the markings on the staple case.

However, Haramiishi teaches a cartridge casing (24) comprising an arrow on the side face of the case for the purpose of indicating the direction in which the case is inserted into the stapler (See Fig. 7 embodiment). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the staple case of Straat with the arrow marking on the side face as taught by Haramiishi in order to show the user the correct direction in which the staple case is to be inserted into the stapler.

Response to Arguments

7. Applicant's arguments filed 4/18/2008 have been fully considered but they are not persuasive. Regarding applicant's argument that Straat does not disclose a pull-out opening located at a vertical center of a front face of the staple case: when examining the claims, the claims must be interpreted as broadly as reasonably allowed. Since there is no reference point provided in the claim, a vertical direction can be in any direction, and a "front face" can be any face on the staple case. The first figure shown above shows the staple case of Straat in an orientation where the pull-out opening is at the vertical center of the front face of the staple case.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Reynolds whose telephone number is (571)272-9959. The examiner can normally be reached on Monday-Friday 9:00am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571)272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mickey Yu/
Supervisory Patent Examiner, Art
Unit 3728

/S. R./
Examiner, Art Unit 3728